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Attorney Docket No. F46.2B-13069-US02

SEP 21 2006

Amendment

REMARKS

This Amendment is in response to the Office Action dated April 21, 2006. Each issue in the official action is discussed below.

§103 Rejections

(21)

Claims 1-9, 11-13 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herz (US 6088722) in view of Von Kohorn US 2001/0003099. A full account of the rejection may be found in paragraph 8 of the official action on pages 10-21.

Although Applicant respectfully disagrees with the rejection, the claims have been amended to further distinguish them from the cited references. Among the amendments made above in response to Examiner's comments in the Response to Arguments in the Official Action, an amendment was made to the independent claims to require that the test video be a production or post production video.

The rejection fails because, in addition to the reasons previously given and among other reasons, each and every element of the claimed invention, as amended, are not accounted for in the cited references. The presently claimed method is tailored for use on production or post-production (ie. still editing, test screening) videos. The testing of these production videos is an aspect not stated in Herz. Herz refers to an "unrated program or portion of a program" (col. 14, lines 25-26), but gives no mention of using this method for videos that are still in the production or post-production phase. It also states in Herz that content profiles for videos come from "all video" programming available for broadcast" (col. 13, lines 27-28). Videos in production or post-production would not, by definition, be "available for broadcast" to customers as part of regular video programming.

There would be no motivation for one skilled in the art to alter the teachings of Herz to use production or post-production video because they are not making videos; they are just trying to determine the types of existing movies the customers prefer. As mentioned in the Official Action, an obviousness rejection requires an establishment of some suggestion, teaching,

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or motivation that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. However, "[t]o support the conclusion that the claimed combination is directed to obvious subject matter, either the references must *expressly or implicitly* suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." (*Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985.) The asserted combination of references is a piece-meal reconstruction of the prior art patents in the light of Applicant's disclosure. "The mere fact that elements of [an invention] may be found in various [references] does not necessarily negate invention." *In re McKenna*, 203 F.2d 717, 721, 97 USPQ 348, 351 (CCPA 1953). There would be no reason for one using the methods of Herz to use production or post-production videos. Nor is there an express or implicit suggestion in the other cited art that the methods of Herz should show the customers unreleased videos to determine their preferences among existing television shows.

As such, for the above stated reasons, the claims 1 and 11 and the claims dependent thereon cannot be considered obvious in light of the cited references. Withdrawal of the rejection is therefore respectfully requested.

(22)

Claims 10 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herz (US 6088722) in view of Von Kohorn US 2001/0003099 and further in view of Haithman. A full account of the rejection may be found in paragraph 9 of the official action on pages 22-23.

Applicant respectfully traverses. In addition to the comments laid out above in regard to claims 1 and 11, claims 10 and 14 and in Applicant's previous response, the rejection further fails because there would be no motivation to use a verification code in conjunction with Herz. As stated in Applicant's first response, Haithman does not ensure that they will watch the entire video. Based on how Herz "tests" videos, there is no motivation to combine the teachings of Haithman with Herz. Herz uses "questionnaires completed by "experts" or some sort of customer's panel, (that) are generated from the test of the video programs themselves, and/or are

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determined by adopting the average of the profiles of those customers who actually watch the video program" (col.4 lines 54-58). There is no necessity to use a verification code, after the fact, because only those customers who have "actually watch(ed) the video program" are the customers asked to fill out the questionnaires under Herz's method. A verification code that would be used to ensure customers fulfill their commitment to watch a test video is not necessary for Herz's method. There would be no motivation to quiz the customers on a specific video because they are not critiquing one particular video, they are providing information on what type of programming they prefer. As such, withdrawal of the rejection is respectfully requested.

The application should now be in condition for allowance. Allowance is therefore earnestly solicited. If the Examiner would like to further discuss the case, he is encouraged to contact the undersigned.

Respectfully submitted,

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